



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,822	01/05/2004	Kazuto Ikemoto	396.43366X00	1645
20457	7590	04/01/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP			LE, HOA VAN	
1300 NORTH SEVENTEENTH STREET			ART UNIT	
SUITE 1800			PAPER NUMBER	
ARLINGTON, VA 22209-3873			1752	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,822

Applicant(s)

IKEMOTO, KAZUTO

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1752

This application is before the examiner for consideration.

A.1. Claims 1-13 are generic to a plurality of disclosed patentably distinct species comprising many possible species of the general alkanolamines. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

2. Claims 3-4 and 10 are generic to a plurality of disclosed patentably distinct species comprising many possible species of the general alkali compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

3. Claims 5-6 and 10 are generic to a plurality of disclosed patentably distinct species comprising many possible species of the general organic solvents. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

4. Claims 5-8 and 10 are generic to a plurality of disclosed patentably distinct species comprising many possible species of the general anticorrosion agent. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 1752

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 and 11-13, drawn to reacted product and process for obtaining the product, classified in class 564, subclass 502. If applicant elected this invention, the application may have to be transferred to a different Technology Center.
- II. Claims 3-11, drawn to a photoresist stripping composition, classified in class 430, subclass 256.

Inventions of Group I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination such as any of the dependent claims 3-10 can be separately patented by itself as separately set up other than on claim 1. The subcombination has separate utility such as fertilizing or corrosive inhibiting agent other than a photoresist stripping composition in any of claims 3-6 and 10. Applicant should show or provide a convincing evidence to the contrary. Otherwise, the restriction on the record would not be removed.

There is no evidence on the record they do not require separate searches because they are not patentably different or distinct. Because these inventions are distinct for the reasons given

Art Unit: 1752

above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

C. Other issues have not been considered until proper elections are made and resolved. However, it is suggested that (1) a compound is used for an agent and (2) a composition is used for a mixture of compounds or agents. There will be no consideration or search of a composition for an agent as that in the claims. It is now notified for the record. Accordingly, a correction should be made in the next response to this Office action.

D. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1752

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
31 March 2005

HOA VAN LE
PRIMARY EXAMINER
